

REMARKS

Claims 1-3 and 5-39 are pending in the application. Reconsideration and allowance of the present application are respectfully requested.

With respect to the foregoing amendments to the specification, the application has been amended to more clearly state the title and the continuity. This wording was recently discussed in the Examiner Interview on March 15, 2007, and, before that, with the Office of Petitions and is in line with each of the applications and patents. It is also important to note that Application Serial No. 09/948,713 (US Patent 6,762,002) includes a priority claim to Application Serial No. 09/538940 and a priority claim to Application Serial No. 09/113,271 (US Patent 6,287,748), and, significantly, the '713 application incorporates by reference the '940 application and the '271 application.

The continuity in the subject case has been clarified to show that the applications in the continuation chain were properly filed and properly claimed priority (and that all of these earlier applications are properly incorporated by reference). The amendment to the specification is in compliance with the previously granted Petition and is further supported by applicant's original filing cover sheet of February 18, 2004.

To assist the continuation claim review, applicant provides the following table.

Filing Date	Grant Date	App. No.	Grant No.	Inventors
2-18-04		10/779,865		Lawton; Chawla
9-10-01	7-13-04	09/948,713	6,762,002	Lawton; Chawla
3-31-00	4-30-02	09/538,940	6,379,866	Lawton; Chawla

2-18-04		10/779,865		Lawton; Chawla
9-10-01	7-13-04	09/948,713	6,762,002	Lawton; Chawla
7-10-98	9-11-01	09/113,271	6,287,748	Lawton
		[corresponds to WO 00/03300]		

The foregoing table was discussed during the interview and provides clear support for the propriety of the specification amendments and the incorporation by reference of the earlier applications.

With respect to the claim amendments, the claims have been amended to place them in better condition for allowance or appeal. No new matter has been added.

First, claims 1, 13 and 17 have been amended to use "5" in place of "0" as supported by the specification, e.g., dating back to claims 7 and 9 and the supporting specification of U.S. Patent No. 6,287,748, which issued from the first application, i.e., Application Serial No. 09/113,271 and which is incorporated by reference. This also supports the ratio range at the end of claims 1, 13 and 17. See, for example, Application Serial No. 09/113,271 at page 5 (as cited on page 7 of the pending Office Action) and page 31 (as cited on page 7 of the pending Office Action).

Second, claims 1, 12, 13, 16 and 17 have been amended to delete the "aliphatic polycarbonate diol" – in line with the Examiner's suggestion at the Interview of March 15, 2007 – and to confirm support for these claims back to the earliest Application Serial No. 09/113,271 (see, e.g., column 13, lines 19-44 of the '748 patent that provides clear support for the "1,4-cyclohexanedimethanol, aliphatic and cycloaliphatic mono hydroxyl alkanols, and linear and

branched polytetrahydrofuran polyether polyols, and combinations thereof." Significantly, these amended claims (effectively claims 1-3 and 5-20), which have support back to the first filed application, render moot the prior art rejections based on Lawton WO 00/03300 – because the cited Lawton reference is a foreign corresponding application to the first filed application and, therefore, is not prior art under any section of the patent statutes.

New claims 21-39 are identical to claims 1-3 and 5-20 before the foregoing amendments to claims 1-3 and 5-50. Stated another way, new claims 21-39 include "an aliphatic polycarbonate diol" in portion (c) just like claims 1-3 and 5-20 used to read. Thus, there is no new matter. In addition, it is important to note that these new claims 21-39 are supported by the earlier Application Serial No. 09/538,940 (see, for example, the disclosure in column 11, lines 11-43 of the corresponding '866 patent – concerning the currently claimed "1,4-cyclohexanedimethanol, aliphatic and cycloaliphatic mono hydroxyl alkanols, an aliphatic polycarbonate diol, and linear and branched polytetrahydrofuran polyether polyols, and combinations thereof." Thus, the cited Lawton reference is not prior art to claims 21-39 under 35 USC 102(b) (because Lawton's publication date of January 2000 is less than one year prior to the '940 filing date of March 2000, and the cited Lawton reference does not anticipate these new claims 21-39 under 35 USC 102(a) because Lawton does not disclose the claimed "an aliphatic polycarbonate diol."

Turning to the pending rejections in the Final Office Action, claims 1-3 and 5-20 have been rejected under 35 U.S.C. § 102(b or optionally a) as allegedly anticipated by WO 00/03300 to Lawton ("WO '300") with a publication date of January 20, 2000. In view of applicant's corrected priority claim (to July 10, 1998) and the claim amendments to claims 1-3 and 5-20, this reference is not prior art. The cited reference is the PCT publication related to U.S. Application

Serial Number 09113271 -- from which priority is claimed for claims 1-3 and 5-20 -- and which was incorporated in its entirety by reference from the outset of this application (and was also incorporated by reference in the '713 application). Thus, all of the supported claim text was in this case from the outset.

Stated another way, in view of applicant's priority claim that predates the cited reference, the reference is not prior art. More specifically, the cited reference was not published (January 2000) more than one year before the earliest application filing date (July 1998); thus, it is not 102(b) prior art. And, it is not "before" the applicant's invention; thus, it is not 102(a) prior art. As a result, applicant requests the withdrawal of the rejection.

Claims 1-3 and 5-20 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant requests the withdrawal of this rejection for at least the following reasons.

The pending application incorporates by reference all of the disclosure in the continuation lineage. All of that disclosure supports the claimed invention, as amended above and as discussed above. To clarify the situation, claims 1, 13 and 17 have been amended to use "5" in place of "0" as supported by the specification, e.g., dating back to claims 7 and 9 and the supporting specification of U.S. Patent No. 6,287,748, which issued from the first application, i.e., Application Serial No. 09/113,271 in 1998 and which is incorporated by reference. The early 1998 application also supports the ratio range at the end of claims 1, 13 and 17. See, for example, Application Serial No. 09/113,271 at page 5 (as cited on page 7 of the pending Office Action) and page 31 (as cited on page 7 of the pending Office Action) and claim 9 in the '748 patent.

LAWTON et al
Appl. No. 10/779,865
March 30, 2007

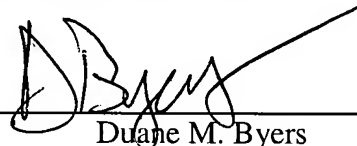
Aside from the detailed descriptions and examples set forth in all of the applications that form part of the pending application, claim 9 in the initial US Patent 6287748 confirms written description support, along with column 17, lines 25-28 of that patent, which complied with Section 112 – otherwise, the patent would not have been granted.

In view of the foregoing amendments, applicant submits that the application is in condition for allowance. A Notice to that effect is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Duane M. Byers
Reg. No. 33,363

DMB:lfo
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100